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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,549	09/04/2003	David W. Roth	B2745.0028/P0028	1609
7590 BEH Investments 1652 48th Street Brooklyn, NY 11204				
EXAMINER				
DAGNEW, SABA				
ART UNIT		PAPER NUMBER		
3688				
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05/20/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/655,549

**Applicant(s)**

ROTH ET AL.

**Examiner**

SABA DAGNEW

**Art Unit**

3688

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 99-166 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 99-166 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Reissue Applications***

1. This Office Action is in response to the amendment filed on June 12, 2008. The amendment replaced previously submitted Claims 99-166 with new Claims 99-166. Therefore, the currently pending claims considered below are Claims 1-17 and 99-166.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

"all oaths/declaration in a broadening reissue application must be signed by all of the inventors (except as otherwise provided in the rules – see 37 CFR §§ 1.42, 1.43, 1.47) In a non-broadening reissue application, either all the inventors or all the assignees must sign the oath or declaration" (MPEP 1410.01).

The instant reissue application contains broadening claims, and, thus, requires the signatures of all of the inventors.

3. Claims 99-166 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 99-166 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 62-218 of copending Application No. 09/216,206. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claims 62 and 133 of copending Application No. 09/216,206 contain all elements of claim 99.

Claims 100-103, 114-121, 123-132, 134-142, 144, 147-155, and 158-166 are rejected since claims 63-66 respectively, shows all elements of claims 100-103, 114-121, and 123-133.

Claims 104-108 are rejected since claims 69, 72, 75, and 78 respectively, shows all elements of claims 104-108.

Claims 109-111, 113, 143, and 145 are rejected since claim 112 respectively, shows all elements of claim 109-111, and 113.

Claims 112 and 146 are rejected since claim 107 respectively, shows all elements of claim 112.

Claims 122, and 156, are rejected since claim 82 respectively, shows all elements of claim 122.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 15, and 99-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (5,794,210)

7. Claims 1, 4, 15, and 99-166 are rejected under 35 U.S.C. 102(e) as being anticipated by

Claims 1-7, 9, 12-14, and 17: Goldhaber discloses a system for supplying advertisements, comprising:

a. a web server storing a plurality of advertisements (*Col. 9, lines 62-67, which teaches Servers 106, store information (advertisement))*);

b. a plurality of bidding agents (*Col. 4, lines 58-62, where "bidding agents" reads on plurality of bidding agents*);

c. a server for providing information concerning each view-op to the bidding agents (*Col. 2, lines 14-21, teaches advertising agency plan different approaches based on demographic lines 36-49, which teaches determining the advertising spot based on demographic information and characteristics of the show for inserting ads*);

d. a bid input system for providing bids including a reference to a specific advertisement, specifications (parameters) for a desired view-op, and a monetary amount to be paid for displaying the specific advertisement (*Col. 5, lines 47-63, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing*

*preference and past consuming behavior (specification) and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction).*

Goldhaber teaches all elements as above including compete by bidding based on viewer's electronic selection of advertisements (**Col. 5, lines 47-63, and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction**) and inserting advertisement during popular television show (**Col. 2, lines 36-49**) and World Wide Web allows anyone to maintain public "home pages" that are visible to all (**Col. 8, lines 50-55**). However, Goldhaber does not explicitly teach the server selecting the highest bid and transferring the advertisement to the web site. However, it would have been obvious to the one ordinary skills in the art at the time of the invention was made to including a feature that selects the highest bidder and transmit advertisement to a web site in order to increase advertising revenue.

Additionally, Goldhaber discloses a similar system for storing a viewer database with demographic and/or historic information pertaining to the viewer (content requestor) that is used by the advertiser to determine the bid amount (**Col. 6, lines 24-31, teaches a data base of digitally stored electronic demographic profile of potential viewers and Col. 4, lines 47-63, bids might be based, in part, on estimates of the viewer's interest and likelihood to buy – estimates derived from access to the viewer's electronic profiles detailing preferences and past consuming behavior** ).

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Claim 8: Goldhaber disclose a system as in Claim 7 above, furthermore, Goldhaber teaches web is accessed using HTTP protocol (**Col. 16, lines 60-64, which teaches URL address, which specified by the activated CyberCoin**)

Claim 10: Goldhaber disclose a system as in Claim 9 above, furthermore, Goldhaber discloses checking the bids to determine if the web page meets (matches) the specification of the bid (**Col. 2, lines 36-49, which teaches determining the advertising spot based on demographic information and characteristics of the show for inserting ads and Col. 20, lines 36-55**).

Claim 11: Goldhaber disclose a system as in Claim 9, furthermore, Goldhaber discloses determination of which advertisement to place on a particular web page in don in machine real time and said bids are entered in human real time (**Col. 8, lines 22-39, which teaches on-line trading (real time) where buyers and sellers (software agents) can actively fined each other an negotiating transaction, read on bids are entered**).

Claim 15: Goldhaber discloses a system as in Claim 1 above, and further discloses the server includes information (database) about web sites (**Col. 6, lines 24-31, teaches database that contains information files and Col. 15, lines 17-31, which teaches brokerage server contain (e.g. opera, winter sport, etc... )**).



Claim 16: Goldhaber discloses a method for supplying and pricing advertisements, comprising:

a. receiving electronic bids from advertisers for specific advertisements to be presented to clients with matching search terms (**Col. 4, lines 54-55, where "bids might be based in part of viewer interest" reads on matching search terms**);

b. transmitting the selected advertisement to the matching clients (**Col. 10, lines 9-15 customer request valuable information (advertisement) delivered to consumer in digital form via the consumer computers**);

c. calculating the delivery fee (bid cost) for the advertisement (**Col. 4, lines 32-40, where "determining direct payment is cost effective" calculating the delivery fee**);  
and

d. generating and transmitting an advertising bill to the advertiser (**Col. 1, lines 57-61, which teaches media receive its revenue from advertiser reads on transmitting adverting bill to advertiser**).

e. storing client profile information in a database and using the profile information to determine the bid amount (**Col. 6 lines 34-30 teaches database that contain electronic profiles detailing preferences and past consuming behavior**).

Goldhaber teaches all elements as cited above including compete by bidding based on viewer's electronic selection of advertisements (**Col. 5, lines 47-63, and Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction**) and inserting advertisement during poplar television show (**Col. 2, lines 36-49**) and World Wide Web allows anyone to maintain public "home pages" that are

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visible to all (**Col. 8, lines 50-55**). Goldhaber does not explicitly teach the server selecting the highest bid and transferring the advertisement to the web site. However, it would have been obvious to the one ordinary skills in the art at the time of the invention was made to including a feature that selects the highest bidder and transmit advertisement to a web site in order to increase advertising revenue.

Claims 99 and 133: Goldhaber discloses a system and method for supplying advertisements, comprising:

b. receiving a request for content from a client including an advertising opportunity (**Col. 10, lines 9-15, which teaches customer request valuable information (advertisement) delivered to consumer in digital form via the consumer computers**);

c. submitting bids based on matching the bidding parameters with the advertising opportunity (**Col. 5, lines 47-63, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (specification)**);

d. including a monetary amount the advertiser is willing to pay if the advertisement is selected to display to the client (**Col. 2, lines 57-21, which teaches mass media (web site) receive its revenue form advertisers;**) and

e. selecting a bid and the corresponding advertisement by a bidding process (**Col. 5, lines 47-63, which teaches advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (specification) and**

**Col. 20, lines 51-55, which teaches agent-aided negotiation and bidding trusted agent transaction).**

Goldhaber teaches all elements as cited above including advertiser compete by bidding based of viewer's electronic bids, detailing preference and past consuming behavior (**Col. 5, lines 47-63**) and database that stores demographic profiles of potential users and electronic trading house that contain buyers and sellers notation transaction (**abstract**) ). Goldhaber does not explicitly teach maintaining (storing) a plurality of bidding parameters associated with an advertisement specifying at least web page characteristics. However, it would have been obvious to the one ordinary skill in the art to at the time of the invention was made to include a feature that stores a plurality of bidding parameters associated with the advertisements in order to identify the advertising media associated with particular advertisement.

**Examiner's Note:** The following limitations are added by numerous dependent claims with crossing dependencies. In order to eliminate redundant rejections of the same limitations, the claims including the same additional limitation have been grouped together.

Claims 100, 113, 123, 134, 147, and 157: Goldhaber discloses a system and method as in Claims 99 and 133 above and further discloses the monetary amount is included in the bid (**Col. 2, lines 57-21, which teaches mass media (web site) receive its revenue form advertisers**).

Claims 101, 114, 124, 135, 148, and 158: Goldhaber discloses a system and method as in Claims 99 and 133 above, and further discloses the specific event is the same for all submitted bids (Goldhaber discloses the event is the selection of the advertisement by the client) (**Col. 2, lines 35-49**, where "TV program" read on event, and "most likely to be purchase" reads on select).

Claims 102, 103, 115, 116, 125, 126, 136, 137, 149, 150, 159, and 160: Goldhaber discloses a system and method as in Claims 99 and 133 above and further discloses the event is delivering (serving) the advertisement ((**Col. 2, lines 35-49**, where "TV program" read on event, and "most likely to be purchase" reads on select).

Claims 104-108, 117-121, 127-131, 138-142, 151-155, and 161-165: Goldhaber discloses a system and method as in Claims 99 and 133 above, including linking ads to content being delivered to audience during TV show (**Col. 2, line s35-49**) and customer request valuable information (advertisement) delivered to consumer in digital form via the consumer computers(**Col. 10, lines 9-15**). Goldhaber does not explicitly teach the request for content by the browser is caused by a reference (link) in a web page. Therefore, it would have been obvious to the one ordinary skill in the art at the time of the invention was made to include browser feature in order to request advertisement via website.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SABA DAGNEW whose telephone number is (571)270-3271. The examiner can normally be reached on 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Saba Dagnew/  
Examiner, Art Unit 3688

/James W Myhre/  
Supervisory Patent Examiner  
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